

## REMARKS

### INTRODUCTION:

In accordance with the following, reconsideration of the allowability of the pending claims is respectfully requested. Claims 1-43 are pending and under consideration.

### REJECTION UNDER 35 U.S.C. §101:

Claims 1, 31 and 43 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. At least for the reasons set forth herein, the Applicants traverse the rejection and respectfully request reconsideration.

Claims 1 and 31 are directed respectively to a method of managing metadata in a metadata transmission server and a metadata transmission server managing metadata security of a multimedia system. Claims 1 and 31 are thus submitted to fit specifically within the "process" category of statutory subject matter under 35 U.S.C. 101. As provided therein:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Since claims 1 and 31 fall within one of the four stated categories of statutory subject matter, the claims are submitted to be directed to statutory subject matter, i.e., statutory per se, within the meaning of 35 U.S.C. 101.

The Office Action asserts regarding claims 1 and 31:

Claims 1 and 31 is directed to a method of managing metadata which includes the steps of generating, selecting and transmitting. However, at the transmitting step, the metadata gets transmitted but does not specify a destination. Therefore the resulted is not a useful, concrete and tangible result.

According to the Guidelines, however, an inquiry as to whether a claim has a practical application is only necessary for claims that include *excluded* subject matter, such as an abstract idea, a law of nature, or a natural phenomenon. In particular, as provided in the Guidelines at page 19, lines 1-9:

For claims including such excluded subject matter to be eligible, the claim must be for a practical application of the abstract idea, law of nature, or natural phenomenon. *Diehr*, 450 U.S. at 187, 209 USPQ at 8 ("application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection."); *Benson*, 409 U.S. at 71, 175 USPQ at 676 (rejecting formula claim because it "has no substantial practical application").

Thus, the “practical application,” consideration is meant to determine whether a claim that includes excluded subject matter is *nevertheless* directed to statutory subject matter, since the claim is for a practical application of the excluded matter. There is no assertion in the Office Action that either of claims 1 or 31 include an abstract idea, a law of nature, or a natural phenomenon in the first place, so requiring them to be directed to a practical application is at least premature, as well as inapposite.

Furthermore, according to the Guidelines USPTO personnel must *first* identify whether the claim falls within at least one of the four enumerated categories of patentable subject matter recited in 35 U.S.C. § 101. In particular, as provided in the Guidelines at page 14, lines 20, 21, and 22, and continuing at page 15, lines 1 and 2:

To properly determine whether a claimed invention complies with the statutory invention requirements of 35 U.S.C. § 101, USPTO personnel must first identify whether the claim falls within at least one of the four enumerated categories of patentable subject matter recited in section 101 (process, machine, manufacture or composition of matter).

Additionally, as provided in the Guidelines, the burden is on the USPTO to set forth a prima facie case of unpatentability. Thus, claims are presumed to belong to one of the four enumerated categories of patentable subject matter recited in 35 U.S.C. § 101 unless the Office is able to show otherwise. In particular, as provided in the Guidelines at page 16, lines 1-4:

The burden is on the USPTO to set forth a prima facie case of unpatentability. Therefore if the examiner determines that it is more likely than not that the claimed subject matter falls outside all of the statutory categories, the examiner must provide an explanation.

Since the Office Action offers no evidence as to why claims 1 and 31 do *not* fall within at least the “process” category, the Office Action fails to set forth a prima facie case of unpatentability, and claims 1 and 31 are submitted to be directed to statutory subject matter within the meaning of 35 U.S.C. 101.

In fact, claims 1 and 31 are method claims, and recite a series of method steps. Claims 1 and 31 are therefore submitted to fit specifically within the “process” category of statutory subject under 35 U.S.C. 101 and are accordingly directed to statutory subject matter within the meaning of 35 U.S.C. 101, whether or not the claims recite “a useful, concrete and tangible result.”

Claim 43 stands rejected under 35 U.S.C. 101, as reciting a machine readable storage including a “carrier wave” as recited in paragraph [0067] of the above-identified application.

Claim 43 is also submitted to be statutory per se, since carrier waves, i.e., signals, are an article of manufacture. The Supreme Court has interpreted the term “manufacture” in accordance with its dictionary definition to mean “the production of articles for use from raw or prepared materials by giving these materials new forms, qualities, properties or combinations, whether by hand-labor or machinery.” *Diamond V. Chakrabarty*, 447 U.S. 303, 308 (1980)(Quoting *Am. Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11 (1931)). As the *Chakrabarty* Court observed, the “expansive” scope of the term “manufacture” reflects Congress’s intent that patentable subject matter “include[s] anything under the sun that is made by man.” *Id.* at 308-09 (quoting S. Rep No. 82-2979 at 5 (1952); H.R. Rep No. 82-1923 at 6 (1952)).

This broad definition of manufacture encompasses electrical signals, which are things made by man. In the electrical arts, a machine, such as a computer produces a signal using electricity (i.e. electrons) to carry information. See Harry Newton, *Newton’s Telecom Dictionary* 622 (17<sup>th</sup> Ed. 2001)(explaining that a signal may be “[a]n electrical wave used to convey information”). The machine transforms the signal into a useful carrier of information by encoding the signal with data through any of a plethora of techniques. Thus, the creation of an electrical signal meets the *Chakrabarty* Court’s definition of manufacture: producing a signal from electricity (i.e., electrons) by giving the electricity new forms, qualities and properties through the data encoding process, where the production occurs by a machine. See *Diamond V. Chakrabarty*, 447 U.S. at 308; see also *Dolbear v. Am. Bell Tel. Co.*, 126 U.S. 1, 533-35 (1888)(holding that claims to the use of electricity to carry vocal sounds – i.e., information – were patentable).

Accordingly, claims 1, 31 and 43 are submitted to be allowable and withdrawal of the rejection under 35 U.S.C. 101 is therefore requested.

#### REJECTIONS UNDER 35 USC 102:

Claim 1-43 stand rejected under 35 U.S.C. 102(e) as being anticipated by Cato et al., U.S. Patent Application No. 2003/0120928 (“Cato”). This rejection is respectfully traversed.

Cato does not disclose at least “generating a plurality of metadata fragment data by partitioning metadata to be transmitted” as recited in independent claim 1.

Cato is directed to a digital rights management system for securely associating rules for authorized use with digital information. More specifically, Cato discusses the distribution “of digital information protected by a cryptographically secure container (CSC) by providing an

unencrypted portion of a data structure that at least in part describes the rules associated with the protected digital information or content. In some embodiments the unencrypted rules description or rules metadata may be part of the secure container data structure..." *Cato at paragraph [0076]*.

However, Cato does not discuss the above-identified features, either in the paragraphs cited in the Office Action, or elsewhere. Rather, all excerpts made in Cato to metadata treat the metadata as a whole, as for example in paragraph [0101]. There, in describing FIG. 9, which is a diagram of example XML code for metadata, Cato states "In the XML code 820 are information pertaining to offers 904, digital content information 908 and credentials 912." It should be noted that nowhere in this description does Cato discuss partitioning the described metadata.

Accordingly, Applicants respectfully submit that independent claim 1 patentably distinguishes over the cited reference, and should be allowable for at least the above-mentioned reasons. Since similar features recited by each of the independent claims 13, 21, 31, 32, 33, 41, 42, and 43, with potentially differing scope and breadth, are not taught or disclosed by the references, the rejection should be withdrawn and claims 13, 21, 31, 32, 33, 41, 42, and 43 also allowed.

Regarding the rejection of claims 2-12, 14-20, 22-30, and 34-40 these claims depend directly or indirectly on one of independent claims 13, 21, 31, 32, 33, 41, 42, and 43, and are therefore believed to be allowable for at least the reasons noted above.

Further, Cato fails to disclose or teach at least "wherein the generated plurality of metadata fragment data are predetermined semantic units of the metadata to be transmitted," as recited in dependent claim 4, and "wherein the metadata fragment data is a predetermined semantic unit of the received metadata" as recited in dependent claims 16 and 28.

Because Cato does not disclose at least "generating a plurality of metadata fragment data," then Cato cannot teach metadata fragment data that are predetermined semantic units. In addition, paragraph [0081], cited in the Office Action describes a metadata and location database 412 for storing local catalogs of files received from all SR applications 408, but does not discuss "predetermined semantic units."

Accordingly, Applicants respectfully submit that dependent claims 4, 16 and 28 patentably distinguish over the cited reference, and should be allowable for at least the above-mentioned reasons.

Cato fails to disclose or teach at least "each metadata fragment data and the corresponding metadata-related information are connected to each other by pointer information." as recited in dependent claims 11 and 20.

Cato, at paragraph [0128], discusses individually packaging hits from a content database search "into a metadata SSC 808" or packaging "many hits from the search query into the same metadata SSC 808." However, Cato does not discuss at least the metadata fragment data and the corresponding metadata-related information connected to each other by pointer information.

Accordingly, dependent claims 11 and 20 patentably distinguish over the cited reference, and should be allowable for at least the above-mentioned reasons.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

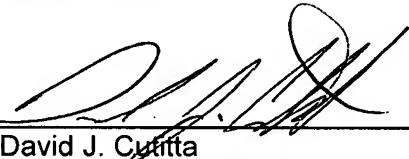
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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